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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/932,784	09/18/1997	JAMES A. MCKAIN	A0521/7125	5693

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EXAMINER
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NGUYEN, HUY THANH

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

08/932,784

Applicant(s)

MCKAIN ET AL.

Examiner

HUY T. NGUYEN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,9 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,9 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/27/06</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 February 2006 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters et al (5,946,445) in view of Kojima et al (5,168,363)..

Regarding claims 1, 9 and 23, Peters discloses a digital motion picture recorder comprising:

- a housing sized to be portable for use by an individual (Fig. 1);
- processing means ( Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal;
- a converting means for converting the motion video signal into a sequence of the still image (column 2);
- storage means (5) for storing the sequence of still images on a computer readable and writable random access medium mounted in the housing (column 3);
- means for specifying a sequence of still images ( video clip or different video clips) to be reproduced (column 3, lines 1-41) ; and
- a motion camera (video camera) )for providing the moving picture to the recorder (Fig. 1).

Peter further teaches the individual can specified a portion of the recorded moving picture to be reproduced ( specifying a sequence the video clips t be reproduced ).

Peters at figure 1 further teaches the recorder can be used with a camera but fails to specifically teach that the motion camera mounted in the housing having the recorder. However, it is noted that combining a camera with recorder for making a portable apparatus is well known in the art as taught by Kojima (Fig. 1, column 1 lines 5-10). Therefore, it would have been obvious to one of ordinary skill in the art to modify the digital recorder of Peters with Kojima by providing a motion camera in the same housing of the digital recorder for portability's purpose therefore providing more advantages to the user in handling the apparatus for capturing the pictures when needed.

Applicant argues that "the combination of Peter and Kojima" is the examiner belief. In response, it is noted that the teaching of arranging a camera and a recorder within a housing is well recognized in the art at the time the invention was made and is used by applicant and it is not the examiner belief. Applicant argues that Kojima teaches a tape recorder not a computer digital computer medium. However it is noted that generating and storing the digital moving picture on a computer writable and readable medium is disclosed by Peter. Peter discusses the difference between tape recorder and computer writable and readable medium and shows where the computer medium is used with a camera. It is clear that the combination of Peter and Kojima as shown by evidences of the references and well recognized in the art and not the examiner belief.

Applicant argues that "one of ordinary skill in the art would not have been motivated to combine the teachings of Kojima and Peters. As noted above, Peters in

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essence teaches a portable computer system that receives a video signal and stores video information in data files on a digital random access computer readable and rewriteable recording medium. Peters states that the computer system can be portable for use in on-site live recording and mentions receiving a signal from a camera, yet Peters does not teach or even suggest that a camera should be included as part of that portable system." In response, the examiner disagrees. Simply incorporating the camera and recorder/player of Peters into the same housing is obvious and can it handle by one of ordinary skill in the art with the teaching of Kojima .

4. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bluth et al (3,617,626) in view of Washino (5,537,157) .

Regarding claims 1, 9 and 23, Bluth discloses a digital motion picture recorder (Fig. 1 columns 3-5) comprising:

- a housing sized to be portable for use by an individual (Fig. 1);
- a motion camera (11) for providing motion video signals (column 12 lines 42-72);
- processing means ( Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal;
- a converting means (13) for converting the motion video signal into a sequence of the still images (frames )(column 12, lines 50-60\_);

storage means (digital recorder means ) for storing the sequence of still images on a readable and writable random access medium mounted in the housing (column 12, lines 54-59)); and

means for selecting a sequence of the stored sequence still mages to be reproduced (column 12, lines 59-65).

Bluth fails to specifically teach that the digital still images (frames ) are stored on a computer readable and writable random access medium . However its noted that processing the motion picture from a camera for processing the motion picture into still frames and storing the digital still images on a digital computer readable and writable random access medium is well known in the art as taught by Washino . Washino teaches a processing means for processing the motion picture from a camera into a digital still images that can be recorded on digital computer readable and writable random access medium (8) (Figs. 2-3, column 6, lnes25- 45, column 8, lines 28 to column 9, line 37). It would have been obvious to one of ordinary skill in the art to modify Bluth with Wasino by using a processing means as taught by Washino for processing the motion picture from the camera into sequence of still mages that can be recorded and read on and from a computer random access medium thereby enhancing the function of the apparatus of Bluth to facilitate accessing and retrieving the stored digital motion picture when needed .

Applicant agues that there is no suggestion for combining Bluth with Washino since Bluth does not teaches a portable housing and Washino does not teaches an editing means.

In response the examiner disagrees. It is noted the electronic recorder of Bluth teaches is a portable since all the circuits of the camera and recorder are connected together (Fig. 1, column 12, lines 42-68) and can be used with an individual. Further the recorder of Bluth inherently having a housing to contain the circuits of the recorder.

Applicant argues that "Washino I states that editing functions are performed in a personal computer. In particular, Washino I states, at Col. 2, lines 45-51 (which is cited in the Final Office Action at page 2, lines 1415), the following (with emphasis added): "In the preferred embodiment, specialized graphics processing capabilities are included in a hi performance personal computer or workstation, enabling the user to edit and manipulate an input video program and produce an output version of the program in a final format which may have a different frame rate, pixel dimensions or both." In response, it is noted that applicant's argument does not reflect the claims. Since the claims recite means for specifying a portion of the digital moving picture to be reproduced that is being taught by Bluth. The editing means recited in claims is a mere means for specifying a portion of the recorded digital moving picture to be reproduced not for changing the format of the reproduced digital moving picture.

The combination of Bluth and Washino will provide means for format the video signal from the camera of Bluth into a digital format that can be read by a computer. Changing the digital video signal of Bluth to readable computer format will enhance the capacity of the system of Bluth and provide more advantage in accessing and retrieving the digital video signal.



5. Claims 1, 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Washino (5,488,433) in view of Scultheis (5,465,120) .

Regarding claims 1, 9 and 23, Washino discloses a digital motion picture recorder (Fig. 1 columns 3-4) comprising:

- a housing sized to be portable for use by an individual (Fig. 1);
- a motion camera (11) for providing motion video signals (column 3, lines 2-30);
- processing means ( Fig. 1) in the housing for receiving the motion video signal from a video camera and a processing the received motion video signal (column 3, lines 3-68, column 4, lines 1-32, 57-68) ;
- a converting means (13) for converting the motion video signal into a sequence of the still images (frames ) (a digital motion or moving picture is a combination of a sequence of still images (frames )
- storage means (digital recorder means ) for storing the sequence of still images on a computer readable and writable random access medium mounted in the housing (column 3, lines 55-68, column 4, lines 14-32) 12, lines 54-59)).

Washino fails to teach means for specifying a portion of the stored sequence still images to be reproduced .

Scultheis teaches a recording /reproducing apparatus having means associated with reproducing means for reproducing a specified portions of a digital moving picture from a computer writable medium (column 2 lines 25-55) .

It would have been obvious to one of ordinary skill in the art to modify Washino with Schultheis by providing the apparatus of Bluth with control means as taught by Schultheis for indicating and specifying a portion of the digital moving picture stored on the medium to be reproduced thereby enhancing the capacity of the apparatus of Washino for providing more convenience to the user in viewing the portions has been captured .

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H.N

  
HUY T. NGUYEN  
PRIMARY EXAMINER